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Paper No.

JAN 20 2005

In re Application of  
Gary K. Michelson  
Serial No. : 09/921,844  
Filed : August 3, 2001  
For : Spinal Implant Surface Configuration

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: DECISION ON PETITION  
: UNDER 37 CFR 1.181(a)  
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This is a decision on the petition under 37 CFR 1.181(a) filed June 22, 2004 for Supervisory Review of the final rejection mailed January 7, 2004 and the advisory action mailed April 23, 2004. There is no fee required for this petition.

### Background

A restriction requirement was mailed October 28, 2002 listing six (6) patentably distinct species of the claimed invention and required applicant to elect a single disclosed species. The examiner identified the distinct species as: Species 1 – figure 4; Species 2 – figure 8; Species 3 – figure 12; Species 4 – figure 16; Species 5 – figure 19B; and Species 6 – figure 20.

Applicant filed a reply to the restriction requirement on April 8, 2003 electing to prosecute the claims that were drawn to species 3, Figs 12-15. Applicant amended some claims and presented some new claims as well. Further, as required, applicant provided a list of the claims that read on the elected species. Applicant traversed the restriction requirement to the extent that it failed to identify any linking claims and proceeded to identify those claims he considered to be linking claims.

An Office action was mailed April 23, 2003 in which the examiner: acknowledged the election; considered the traversal but did not find it persuasive as it did “not address the basis of a species requirement”; made the restriction requirement final; rejected some claims under 35 USC 112, some under 35 USC 102, and others under 35 USC 103; and objected to the drawings under 37 CFR 1.83(a) as not showing some of the claimed features.

On October 9, 2003 applicant filed a response that cancelled some claims, added new ones and amended the specification, drawings, and some of the claims.

On January 7, 2004 a final Office action was mailed with the examiner: (a) listing some claims as being withdrawn from consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species and informing applicant that a complete response to the final must include a cancellation of these claims; (b)

objecting to the specification as including new matter; (c) objecting to the drawings under 37 CFR 1.83(a); (d) rejecting claims under 35 USC 112, 35 USC 102 and 35 USC 103; and (e) answering applicants arguments.

On March 26, 2004, applicant filed a paper requesting rejoinder of the claims that the examiner had indicated withdrawn as being drawn to a nonelected species, and withdrawal of the finality of the previous Office action.

An advisory action was mailed April 23, 2004 informing applicant that the finality of the previous Office action was proper and that the request for rejoinder of the claims was not deemed persuasive.

On June 22, 2004 the instant petition was filed.

### **Discussion**

Petitioner specifically requests: (1) withdrawal of the finality of the Office action mailed January 7, 2004; (2) the rejoinder of claims improperly withdrawn by the examiner as being drawn to a nonelected species; and (3) that the examiner's requirement that applicant cancel elected claims that the examiner has improperly characterized as nonelected claims made in the final Office action be rescinded.

#### **A. Propriety of the Finality of the Office action mailed January 7, 2004.**

Section 706.07(a) of the Manual of Patent Examining Procedure (MPEP), Revision 2 dated May 2004, discusses the guidelines to be followed when making an Office action final. The MPEP indicates that an action may be made final on a second action "except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c)".

In the final Office action of January 7, 2004, claims 43 and 247 (dependent from claims 1 and 219, respectively) were rejected under 35 USC 112, second paragraph, indicating that the limitation "motion preserving device" caused the claims to be indefinite. The amendment filed October 9, 2003, to which the final Office action is responsive to, did not amend claims 43 and 247. The amendment of October 9, 2003 did make changes to claims 1 and 219 but in areas totally unrelated to the limitation of claims 43 and 247 noted above that the examiner feels renders the claims indefinite. The amendment of October 9, 2003 dealt with the phrases "bone engaging structures" and "surface projections", as the examiner had questioned in the Office action of April 23, 2003 if there were any differences between the two elements. Claims 43 and 247 deal with the overall structure and function of the device rather than a specific surface configuration.

Accordingly, as the subject matter of claims 43 and 247 was not affected by the amendment filed October 9, 2003, the new ground of rejection of claims 43 and 247 was not necessitated by applicant's amendment and therefore, the making of the Office action final was premature.

Thus, the petition to withdraw the finality of the Office action mailed January 7, 2004 is **GRANTED**.

B. Propriety of the holding of some claims withdrawn as being drawn to a nonelected invention as well as the requirement to cancel these claims.

Applicant submits that the examiner improperly withdrew from consideration claims 131, 133, 135, 137-145, 205, 206, 213-215, and 272-276 (hereinafter "the claims in question") in the final Office action for at least one of the following grounds: (1) the examiner had previously confirmed that the claims in question did read on the elected species; (2) the claims in question include a feature that distinguishes the elected species from other species; and (3) the examiner's rationale for withdrawing the claims is not applicable in view of the restriction requirement of record.

It is noted that in response to the restriction requirement mailed October 28, 2002, applicant indicated that claims 131, 133, 135, 137-145, 205, 206, and 213-215 read on the elected species (see page 1 of the amendment filed April 8, 2003 as well as page 12). The examiner, by the treatment on the merits of the claims in question in the Office action mailed April 23, 2003, in essence, agreed that the claims in question read on the elected species. However, the examiner, in the next Office action, the final action mailed January 7, 2004 withdrew the claims in question from consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected embodiment indicating that the elected embodiment shown in figures 12-15 has left and right facets that are identical and therefore, the left facet is not steeper than the right facet as recited in claim 131.

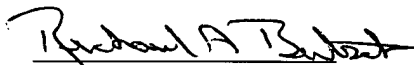
The feature that differentiates species 3 from all other species is the fact that the surface projections include an angle greater than 90 degrees. This feature is in independent claim 131 (all other of the claims in question depend, directly or indirectly from claim 131) and was added by the amendment filed October 29, 2003. The feature that the examiner relies on in the final Office action to base his assertion that the claims are drawn to a nonelected embodiment has been present in claim 131 from the beginning. What the examiner appears to have failed to realize is that the orientation of the surface projections in claim 131 are rotated 90 degrees with respect to that of all other disclosed embodiments. That is, what is front and rear in all other embodiments is right and left, respectively, in claim 131. Similarly, right and left are front and rear, respectively, in claim 131. Disregarding for a moment the orientation of the surface projections, the shape of the surface projections recited in claim 131 is generic to all embodiments. That is, each surface projection has two facets, each facet having a length and a slope, wherein the first facet is longer than the second facet and the slope of the second facet being steeper than the slope of the first facet.

Thus, the reason given for withdrawing from consideration the claims in question as being drawn to a nonelected embodiment, that is, the orientation of the surface projections, is not applicable as it was not indicated, in the election of species requirement mailed October 28, 2002, as one of the patentably distinct species from which applicant was required to pick from. Accordingly, in view of the above, it is determined that in the Office action mailed January 7, 2004, the examiner improperly characterized the claims in question as being drawn to a nonelected species and therefore, improperly withdrew the claims in question from further consideration and improperly required the cancellation of these claims.

In view of the above, (1) the examiner's requirement that applicant cancel claims 131, 133, 135, 137-145, 205, 206, 213-215, and 272-276 is hereby rescinded, and (2) the above noted claims are rejoined and will be fully examined<sup>1</sup> for patentability under 37 CFR 1.104.

### **Conclusion and Summary**

The finality of the Office action mailed January 7, 2004 is hereby withdrawn. The requirement that applicant cancel claims 131, 133, 135, 137-145, 205, 206, 213-215, and 272-276 is hereby rescinded. The above noted claims are rejoined. Upon the mailing of this decision, the application will be returned to the examiner for the preparation of a new non-final Office action that is consistent with this decision.



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<sup>1</sup> It is noted that 37 CFR 1.142(a) provides that a restriction requirement can be made at any time before final action at the discretion of the examiner. Thus, if the examiner is of the opinion that the subject matter recited in the claims in question (represented in Fig. 12B) is a patentably distinct species, he has the option of requiring a new election of species.